

IN RESPONSE TO THE OFFICE ACTION

Claim Rejections under 35 U.S.C. § 102(b)

The Examiner has rejected claims 1-4, 7, 9-26 and 37-41 under 35 U.S.C. § 102(b) as being anticipated by Ahlf (U.S. Patent No. 4,151,540). The Examiner has argued that Ahlf discloses much of the instant application, and therefore anticipates the rejected claims. Specifically, the Examiner states that Ahlf describes a process in which an active chemistry is introduced onto a workpiece that is capable of reacting with the workpiece so as to form a conversion coating on the workpiece. The Examiner also states that Ahlf teaches that after the conversion coating is formed on the workpiece, a tool is contacted with the workpiece with a relative motion there between, continuously removing the conversion coating and allowing it to reform until a desired surface property of the workpiece is reached.

This rejection is exactly the same as the rejection set forth by the Examiner in the Office Action dated December 19, 2003. In response to that office action, Applicants submitted a 37 C.F.R. § 1.132 affidavit from one of the inventors, Dr. Gary J. Sroka, showing that Ahlf disclosure is non-enabling and inoperable as it pertains to the formation of a conversion coating on the workpiece. Applicant hereby maintains this position.

In response to Applicants' submission of this affidavit, the Examiner first stated in the Final Office Action that the affidavit is insufficient to overcome this rejection for the following reason:

4. The declaration under 37 C.F.R. 1.132 filed 18 March 2004 is insufficient to overcome the rejection of claims 1-4, 7, 9-26 and 37-41 based upon 35 U.S.C. 102(b) as being anticipated by Ahlf as set forth in the last Office action because: facts presented are not germane to the rejection at issue.
5. It refers only to the system described in the above referenced application and not to the individual claims of the application. Thus there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

6. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Final Office Action dated June 15, 2004, at paragraphs 4-6.

This argument appears to be misguided, as Dr. Sroka's § 1.132 affidavit was submitted to show the inoperability and non-enablement of Ahlf as it pertains to the formation of a conversion coating on a piece of metal for the purposes of finishing the surface of the metal. There was no obviousness rejection presented in the December 19, 2003 Office action. Therefore, Applicants presented no arguments in support of the nonobviousness of the currently pending claims. Applicants therefore request that the Examiner clarify this argument, as it appears to have no relevance to the rejection at hand.

The Examiner's second response to Applicants submission of Dr. Sroka's § 1.132 affidavit was as follows: "In response to applicant's argument that Ahlf is inoperative and fails to teach one of ordinary skill in the art the invention disclosed therein, Ahlf clearly anticipates claims 1-4, 7, 9-26 and 37-41 as disclosed in col. 2, line 15 to col. 4, line 21." Final Office Action dated June 15, 2004 at ¶ 7. It is the argument that Ahlf is inoperable and non-enabling with respect to the currently pending claims to which Applicants submitted Dr. Sroka's § 1.132 affidavit in rebuttal.

The law is clear that to be prior art under section 102(b), a reference must be enabling. In other words, the reference must put the claimed invention in the hand of one skilled in the art. *In re Sun*, 31 USPQ 2d 1451, 1453 (Fed. Cir. 1993) (unpublished); *see also Seymour v. Osborne*, 78 U.S. 516, 555, 20 L. Ed. 33 (1870) ("The knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention."). For a publication to constitute an anticipation of an invention and, thus, to bar the grant of a patent under 35 U.S.C § 102, it must be capable, when taken in conjunction with the knowledge of those skilled in the art to which it pertains, of placing that invention in the possession of the public. *Ex parte Humphreys*, 24 USPQ 2d 1255, 1261-62 (B.P.A.I. 1992) (citing in *In re Donohue*, 632 F.2d 123, 207 USPQ 196 (C.C.P.A. 1980)). Simply stated, a prior publication or patent description can be considered as anticipatory only when its

disclosure is at once specific and enabling with regard to the particular subject matter at issue. *In re Wilder*, 166 USPQ 545, 548 (C.C.P.A. 1970).

However, such disclosure may yet be held not to legally anticipate the claimed subject matter if it is found not to be sufficiently enabling, in other words, if it does not place the subject matter of the claims within "the possession of the public." *Id.* A single anticipating reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention. *Crown Operations International, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ 2d 1917, 1921 (Fed. Cir. 2002); *In re Spada*, 911 F.2d 705, 708, 15 USPQ 2d 1655, 1657 (Fed. Cir. 1990) ("the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it"); *Elan Pharmaceuticals Inc. v. Mayo Found. for Med. Educ. and Research*, 304 F.3d 1221, 64 USPQ 2d 1292, 1296 (Fed. Cir. 2002). Thus, as applied to the present case, to anticipate the currently pending claims, Ahlf must enable one of ordinary skill to reproduce the claims of the present invention. Ahlf does not do this.

As thoroughly set forth in Dr. Sroka's § 1.132 affidavit, and not solely based on attorney argument, Ahlf is nonenabling and inoperable because it fails to enable one having skill in the art to recreate the claimed invention using Ahlf, as required by law. Applicant refers the Examiner to the response to the December 19, 2003 Office action and the accompanying § 1.132 affidavit to show that Ahlf is nonenabling and inoperable. To summarize, Ahlf is nonenabling because it does not disclose enough information to allow one of ordinary skill in the art to repeat the claimed invention. As clearly shown in Dr. Sroka's affidavit, several critical elements necessary to replicate the process of the present claims are missing from Ahlf, thereby requiring Dr. Sroka, and others of skill in the art, to read into Ahlf several elements of the process. Dr. Sroka had to make many assumptions that were not disclosed in Ahlf in order to attempt to repeat the Ahlf disclosure, but was unsuccessful.

The process claimed in independent claim 1 clearly calls for the formation of a conversion coating on the surface of the metal. This is not the same as dissolving the metal, the

mechanism that was actually disclosed in Ahlf. See Dr. Sroka's § 1.132 Declaration at ¶ 18-32. The conversion coating claimed in the present invention produces "a soft conversion coating on the basis metal" and "protects the basis metal from further reaction so as to ensure that metal removal occurs primarily by rubbing and re-formation rather than by dissolution." 10/071,533 Application at p. 6, ll. 21-25. Clearly the conversion coating is not the same as dissolution, and is therefore not anticipated by the non-operable, non-enabling Ahlf disclosure.

As clearly stated above, an anticipating reference can not legally anticipate a claim subject matter if it is found not to be sufficiently enabling, and does not place the subject matter of the claims within "the possession of the public." *In re Wilder*, 166 USPQ 545, 548 (C.C.P.A. 1970). While the Examiner states that Ahlf does disclose the present invention, a point that Applicants do not agree with, Ahlf still does not place the subject matter of the currently pending claims within "the possession of the public." *Id.* Dr. Sroka concluded that the mechanism disclosed in Ahlf **did not** in fact teach the formation of a conversion coating on a piece of metal, but actually described the dissolution of the metal. Dr. Sroka § 1.132 Declaration at ¶ 18-32. Therefore, while Ahlf arguably discloses in words the presently claimed invention, it is not the disclosure of the currently pending claims that Ahlf places within the possession of the public. Ahlf actually discloses to the public the dissolution of metal, not the formation of a conversion coating that is required of the currently pending claims. Thus, based on the extensive experimental evidence provided by Dr. Sroka, Ahlf is clearly inoperable and non-enabling as it pertains to the formation of a conversion coating on a piece of metal as required by the instant claims.

MPEP § 716 sets forth the process for submitting § 1.132 affidavits as evidence, with § 716.07 being most applicable to the issue at hand: submitting an affidavit pertaining to the inoperability of cited references. As clearly stated in MPEP § 716.01(B), the Examiner must have commented on Dr. Sroka's affidavit in this action. MPEP § 716.01(B) clearly states that if the Examiner felt that the affidavit was insufficient to overcome the rejection, the Examiner "must specifically explain why the evidence is insufficient. General statements such as 'the declaration lacks technical validity' or 'the evidence is not commensurate with the scope of the claims' without an explanation supporting such findings are insufficient." MPEP § 716.01(B).

Applicants respectfully submit that the Examiner did not sufficiently explain why Dr. Sroka's affidavit failed to overcome the 102(b) rejection by showing that Ahlf is inoperative and non-enabling. Instead, the Examiner merely stated that the Examiner's only explanation, that "Ahlf clearly anticipates claims 1-4, 7, 9-26 and 37-41" is a general statement and is not sufficient to reject Dr. Sroka's affidavit under MPEP § 716.01(B). Therefore, if the Examiner finds Dr. Sroka's affidavit insufficient to overcome the 102(b) rejection, Applicants respectfully request that the Examiner comply with MPEP § 716.01(B) in the next paper from the office and specifically explain why the evidence is insufficient. Applicants contend that once the Examiner reads Dr. Sroka's affidavit in view of the arguments presented herein and in the prior office action response, and in view of the well-established law that an anticipating reference must be operable and enabling to the claims, the Examiner will find that the present claims are allowable over Ahlf.

Given the above, viewed in light of Dr. Sroka's § 1.132 affidavit filed with Applicants' response to the December 19, 2003 Office action, Ahlf is inoperable and non-enabling with respect to the formation of a conversion coating on a piece of metal, a limitation that is specifically required by the currently pending claims. Applicants therefore assert that Ahlf can not legally anticipate the claims of the present invention. Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 102(b) rejection of claims 1-4, 7, 9-26 and 37-41, and indicate their allowance in the next paper from the office.

Applicants request for any extension of time that may be deemed necessary to further the prosecution of this application.

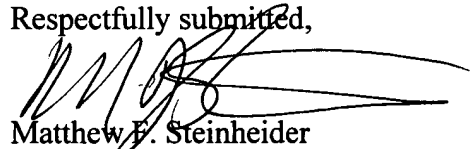
Applicants' representative authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 01-2508, referencing Order No. 12350.0010.NPUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, Applicants respectfully request that the Examiner directly contact the undersigned by phone to further the discussion.

Serial No.: 10/071,533
Confirmation No.: 1312
Applicant: Michaud, et al.
Atty. Ref.: 12350.0010.NPUS00

In order to promote the prosecution of this application, the Examiner is authorized to contact the undersigned by electronic mail. Please address all e-mail to:
steinheidern@howrey.com

Respectfully submitted,



Matthew F. Steinheider
Attorney for Applicants
Reg. No. 47,968
Tel. (713) 787-1516
Date: 9/15/04